

REMARKS/ARGUMENTS

Applicants thank the Examiner for his consideration of the application. Claims 1-4, 6, 9-17, 20-22, 26 and 29-30 remain pending in the application. Claim 34 is cancelled herein without prejudice or disclaimer.

35 U.S.C. § 102 Rejections

The Examiner rejected claims 1-4, 6, 9-13, 20-21, 26 and 29-30 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,643,194 issued to Negre ("Negre"). Independent claim 1 is directed to a valve for an implantable fluid delivery system and independent claim 29 is directed to a fluid switch for an implantable fluid delivery system. Both systems include, among other things, an internal magnet disposed within a fluid chamber, the internal magnet capable of movement in at least two directions, one direction along an axis and one direction rotatable about the axis, the internal magnet being moveable such that displacement of the internal magnet restricts the flow of fluid through the fluid chamber.

Negre does not disclose, teach or suggest an internal magnet capable of movement in at least two directions, one direction *along an axis* and one direction rotatable about *the axis*. Rather, Negre discloses magnets that rotate about a central axis and move in a radial direction toward the central axis, not along the central axis. The Examiner states that Negre discloses magnetic elements being able to move in a rotational motion and a positional displacement. Office action dated August 25, 2006 at 2. Although this may be true, claims 1 and 29 specifically require that the at least two directions include one direction *along an axis* and one direction rotatable about *the axis*. Thus, Negre does not disclose, teach or suggest a valve or

fluid switch having this configuration. Instead, Negre discloses a subcutaneous valve that includes, among other things, a body having a substantially cylindrical and flat internal chamber having a central axis, two micromagnets mounted in spaced relation in the rotor and arranged on opposite sides of the central axis of the chamber and locking means for locking the rotor. The micromagnets are mounted to move linearly in the rotor in a substantially radial direction to actuate the locking means. *See*, e.g., abstract and FIGS. 1 and 2. Negre further discloses that the rotor includes lateral branches which serve as guide means for moving parts (10, 11), each housing a micro-magnet (12, 13). The moving parts can move linearly inside the rotor in a substantially radial direction. *See*, e.g., col. 3, lines 60-67. The locking means consists of cylindrical lugs (10a, 11a) projecting from the moving parts. *See*, e.g., col. 4, lines 1-2.

The Examiner also claims that Negre discloses “various internal magnetic components that are multiple cylindrical and spherical shapes.” Office action dated August 25, 2006 at 3. Applicants respectfully disagree. The micro-magnets disclosed and shown in FIGS. 1 and 2, are square or rectangular in shape. Other various *non-magnetic* internal components are, however, disclosed such as the cylindrical and flat internal chamber, the non-return valve consisting of a ball and a cone-shaped seat, a semi-circular leaf spring, or stop elements. *See*, e.g., col. 1, lines 66-67; col. 4, lines 5-9.

In addition, the Examiner does not appear to address the fact that Negre does not disclose, teach or suggest one or more grooves in the movable, internal magnet or a coating thereon, as required by claims 13 and 17. Negre discloses that the locking means includes a lug projecting from the moving parts and cavities for accommodating the lugs formed in a circle in the chamber. *See*, e.g., col. 2, lines 19-23 and FIGS. 1, 3 and 4. However, Negre does not

disclose, teach or suggest a valve having one pole of an internal magnet or a coating on one pole of an internal magnet that includes "one or more grooves" as required by claims 13 and 17.

Therefore, Negre does not disclose, teach, or suggest, an "internal magnet capable of movement in at least two directions, one direction along an axis and one direction rotatable about the axis" as required by claims 1 and 29. Accordingly, independent claims 1 and 29 are patentable in light of the cited prior art for at least the reasons cited above. Dependent claims 2-4, 6, 9-17, 20-22, 26 and 30 depend directly or indirectly from independent claims 1 and 29, and thus contain all of the limitations of the independent claims from which they depend. Thus, these dependent claims are patentable over the cited prior art for at least the same reasons set forth above with respect to claims 1 and 29.

The Examiner rejected claim 34 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,371,670 issued to Loe ("Loe") or U.S. Patent No. 3,777,737 issued to Bucalo ("Bucalo"). Claim 34 is cancelled herein, without prejudice or disclaimer.

35 U.S.C. § 103 Rejections

The Examiner rejected claims 21-22 under 35 U.S.C. § 103(a) as being unpatentable over Negre in view of U.S. Patent Appl. No. 2002/0108623 issued to Rehder et al. ("Rehder"). As mentioned above, claims 21 and 22 are patentable over the cited prior art, either alone or in combination, for at least the same reasons set forth above with respect to claim 1.

The Examiner rejected claims 14-17 under 35 U.S.C. § 103(a) as being unpatentable over Negre. As mentioned above, claims 14-17 are patentable over the cited prior art for at least the same reasons set forth above with respect to claim 1.

Serial No.: 10/726,066
Amdt. Dated: November 7, 2006
Reply to Office action of August 25, 2006

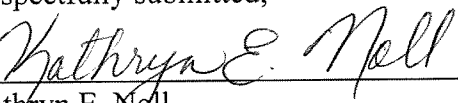
Page 12 of 12

CONCLUSION

Applicants respectfully request that the Examiner consider the Supplemental Information Disclosure Statement (IDS) filed with the last response on May 17, 2006 and received by the U.S. Patent and Trademark Office on May 19, 2006. A copy of the previously filed IDS and form PTO-1449 are enclosed for convenience along with the return receipt postcard showing receipt of the items.

All the claim rejections have been addressed and all of the pending claims are allowable for the reasons stated and others. Reconsideration of the application and issuance of a notice of allowance are respectfully requested. Applicant believes that no additional fees or an extension of time is required. Please apply any additional charges or credits to Deposit Account No. 19-4972.

Respectfully submitted,



Kathryn E. Noll
Reg. No. 48,811
Attorney for Applicants

DATE: November 7, 2006

BROMBERG & SUNSTEIN LLP
125 Summer Street
Boston, MA 02110-1618
Tel: 617 443-9292
Fax: 617 443-0004